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| EXAMINER | | | | |
| FOUD, HICHAM B | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2419 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,479

Applicant(s)

MAKINEN ET AL.

Examiner

HICHAM B. FOUD

Art Unit

2419

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/18/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 12-12-2008 has been entered and considered.

Claims 1, 3-8 and 10-15 are pending in this application.

Claims 2 and 9 have been canceled.

Claims 14-15 are added.

Claims 1, 3-8 and 10-15 remain rejected as discussed below.

Drawings

2. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 15 recites "computer program embodied on a computer readable medium, the computer program configured to control a processor". However, the specification as originally filed does not adequately describe the recited feature. Thus, Examiner concludes that the claimed feature indicated above is a new matter and without further teachings, one skilled in the art does not know how to make and use the claimed invention without undue experimentation

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 6, 8, 10-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse et al (US 6,104,929) hereinafter is referred to as Josse in view of Sjoblom (US 7,310,331).

For claim 1, Josse discloses a method comprising the steps of: detecting a serving system node change request from a target (MS) towards a serving system node which is currently not serving the target (see Figure 4A step 4-1 and column 12 lines 9-19; the sending of a routing area update request message), processing said serving system node change request at said serving system node currently not serving the target, wherein said processing comprises the inclusion, to the request, of a serving system address of the serving system node currently not serving the target (see Figure 4A step 4-2a and column 12 lines 22-27; the inclusion of the new SGSN address), and forwarding said processed request to an serving system node currently serving the target (see Figure 4A step 4-2a and column 12 lines 22-27; wherein the request is sent to the old SGSN). Josse discloses all the subject matter with the exception of wherein the method is for informing a lawful interception system of the serving system serving an intercepted target (MS). However, Sjoblom discloses a method wherein the serving system informs the lawful interception system of the serving system serving an intercepted target (MS) (see Figure 1 and column 1 line 27 to column 2 line48; wherein GSN "element 3" is connected to the lawful interception system LEA "element 1" and sending information through the interfaces X0_1, X0_2 and X0_3; such as IRI which is the interception related information). Thus, it would have been obvious to the one skill in the art at the time of the invention to have a connectable lawful interception system to

the GSN system as taught by Sjoblom into the method of Josse for the purpose of interception of information and therefore performing a lawful interception.

For claims 3 and 10, Josse discloses a method further comprising detecting at least one active communication context for said target (see Figure 4A step 4-4a and column 12 lines 64-67; PDP context operations), generating a communication context update request to which is included the serving system address of the serving system node currently not serving the target (see Figure 4A step 4-6 and column 13 lines 33-38; wherein the use of the update SGSN address request message that contains the address of the new SGSN), and forwarding said generated request to a gateway serving system node of the serving system currently serving the intercepted target (see Figure 4A step 4-6 and column 13 lines 33-38; wherein the update SGSN address request message is sent from the new SGSN to the GGSN).

For claims 5 and 11, Josse discloses a method wherein said serving system address of the serving system node represents information about the serving system to which said serving node belongs (see column 12 lines 35-38; the new address represents information, to which said new serving node belongs, that is required to allow the old SGSN to forward packets to the new SGSN until the old MM context is cancelled).

For claims 6 and 12, Josse discloses a method, wherein said information about the serving system to which said serving node belongs comprises at least one of the

following information items: serving node number, serving node routing area identifier, serving node address (see column 12 lines 26-28; the new address, RAI).

Claims 8, 14 and 15 are rejected for same reasons as claim 1, because it would have been obvious to the one skill in the art at the time of the invention to implement a method into an apparatus and/or computer program for the purpose of making and/or programming the devices to function as directed by the method.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Josse in view of Sjoblom (US 7,310,331) and further in view of Miettinen et al (US 6,754,834) hereinafter is referred to as Miettinen.

For claim 4, Sjoblom further discloses that GSN node detects and transmits IRI (interception related information) to the lawful interception system, wherein the GSN node can be either SGSN or GGSN (see Sjoblom Fig. 3, column 6 lines 20-25 and column 7 lines 14-16). Josse in view of Sjoblom discloses all the subject matter with the exception of explicitly disclosing wherein said gateway serving system node currently serving the target informs the interception system of the new serving system address of the serving system node. However, Miettinen discloses that the IRI may include location information that is related to roaming since the location information changes according to the location (see Miettinen column 6 lines 27-35). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the interception method as described in Miettinen into the method of Josse in view of Sjoblom to include the address of the new SGSN in the IRI sent by either SGSN (old or new) or GGSN to

the interception system for the purpose of performing a lawful interception that intercepts the target even when the target is roaming in different cells.

7. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse in view of Sjoblom and further in view of Neumann (US 6,792,270).

For claims 7 and 13, Josse in view of Sjoblom discloses all the subject matter with the exception of explicitly disclosing wherein said serving node routing area identifier comprises information items representative of a mobile country code, mobile network code, location area code, and routing area code. However, Neumann discloses a method wherein said serving node routing area identifier contains information items representative of a mobile country code MCC, mobile network code MNC, location area code LAC, and routing area code RAC (see column 5 lines 26-29). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the component of the RAI as disclosed in the invention of Neumann into the method of Josse in view of Sjoblom for the purpose of clearly identifying a routing area worldwide.

Response to Argument

8. Applicant's arguments filed have been fully considered but they are not persuasive.

9. In regard of the argument in pages 11-12 of the Remarks concerning the drawings, the examiner disagrees with the applicant because it is admitted by the applicant that Figures 2 and 3 are taken from 3GPP TS 23.060 (see specification page

11 line 28 and page 18 line 11). Moreover, in Figure 1, besides the admission of the applicant that Figure 1 shows a reference configuration for GPRS (see specification page 11 line 1) and well described in the BACKGROUND OF THE INVENTION section of the instant application, it is shown in Sjoblom "2nd reference"; which was filed prior to the instant application; as PRIOR ART (see Sjoblom: Figure 1) and also specified in TS 33.107 (see 3GPP TS 33.107 V5.2.0 page 9 Figure 1b). Thus, the Figures 1-3 are prior art and must be labeled as prior art.

10. In response to the argument in pages 17-22 of the Remarks, that Josse does not teach the limitation "the inclusion, to the request, of a serving system address of the serving system node currently not serving the target", the examiner respectfully disagrees because the term "a serving system address of the serving system node" is very broad term and reads on the serving system node address (see Josse: Figure 4A step 4-2a and column 12 lines 22-27; the inclusion of the new SGSN address). Thus, if a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. Ex parte Ionescu, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Therefore, claims are given their broadest reasonable interpretation (The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)) because although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, it

is admitted by the applicant that the claimed "a serving system address of the serving system node" can be the serving node address (see specification page 8 lines 10-19). Therefore, Josse teaches the argued limitation.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed

invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hicham B. Foud whose telephone number is 571-270-1463. The examiner can normally be reached on Monday - Friday 10-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/Hicham B Foud/
Examiner, Art Unit 2419
03/16/2009

/Wing F. Chan/
Supervisory Patent Examiner, Art Unit 2419
3/26/09